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Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1958

No. [redacted] 147

S. C. JOHNSON & SON, INC., *Petitioner*,

v.

PHIL J. JOHNSON and HUGH H. JOHNSON, d. b. a. JOHNSON PRODUCTS CO., *Respondents*.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT.

FRANCIS C. BROWNE
WILLIAM E. SCHUYLER, JR.
ANDREW B. BENERIDGE
WALTER P. ARMSTRONG, JR.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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No.

S. C. JOHNSON & SON, INC., *Petitioner,*

v.

PHIL J. JOHNSON and HUGH H. JOHNSON, d. b. a. JOHNSON PRODUCTS CO., *Respondents.*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, S. C. Johnson & Son, Inc., respectfully prays for a writ of certiorari to the United States Court of Appeals for the Sixth Circuit to review the judgment of a majority of that court[1] affirm-

[1] Mr. Justice Stewart heard oral argument on the appeal before appointment to the Supreme Court but did not participate in the decision, opinion or judgment in the case.

ing the judgment of the District Court, dismissing petitioner's complaint for common law and federal statutory trademark infringement.

I. OFFICIAL REPORTS OF THE OPINIONS BELOW

(a) Decision of Sixth Circuit Court of Appeals

S. C. Johnson & Son, Inc. v. Johnson et al, dba Johnson Products Company, F. 2(d) ; 121 United States Patent Quarterly 63: (Text of decision set forth herein as Appendix I)

(b) Decision of District Court for Western District of Tennessee

S. C. Johnson & Son, Inc. v. Johnson et al, dba Johnson Products Company, F. Supp. (unreported). (Text of Findings of Fact and Conclusions of Law set forth in Record, Appendix to Appellant's Brief, page 21a)

II. JURISDICTION

(i) Judgment entered March 30, 1959.

(ii) Rehearing denied May 18, 1959.

(iii) Jurisdiction conferred to review judgment of circuit court by writ of certiorari under Title 28, United States Code, Section 1254(1).

III. QUESTION PRESENTED FOR REVIEW

Should some restriction be placed upon respondent who does not limit use of his surname ("JOHNSON") to the company name ("JOHNSON PRODUCTS COMPANY"), but who prominently displays it in trademark fashion ("JOHNSON MOP") on labels for his floor mops, and who emphasizes the trademark significance of the surname by use in slogans ("Nationally known JOHNSON MOPS", "It Pays

to Buy a Johnson Mop" and "Always Ask For a JOHNSON WET MOP") on those labels, where petitioner has used its famous registered trademark ("JOHNSON'S") over nearly three-quarters of a century in connection with a wide variety of floor maintenance materials and equipment (floor waxes, floor cleaners, floor polishers and floor wax appliers) and the purchasing public recognizes and relies upon that trademark as an indication of origin of such goods in petitioner.

IV. STATUTES INVOLVED

1. Chapter 22, Title 15, United States Code, Section 1114(1), (Section 32(1), Trademark Act of 1946), Public Law 489, 79th Congress, Chapter 540, approved July 5, 1946, 60 Stat. 427, as amended by Public Law 710, 81st Congress, 64 Stat. 459, Act of August 17, 1950, and Public Law 593, 82nd Congress, 66 Stat. 792, Act of July 19, 1952:

> "Sec. 32 (1). Remedies—Infringement
>
> Any person who shall, in commerce, (a) use, without the consent of the registrant, any reproduction, counterfeit, copy, or colorable imitation of any registered mark in connection with the sale, offering for sale, or advertising of any goods or services on or in connection with which such use is likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services; or (b) reproduce, counterfeit, copy, or colorably imitate any such mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with the sale in commerce of such goods or services, shall be liable to a civil action by the registrant for any

or all of the remedies hereinafter provided, except that under subsection (b) hereof the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such mark is intended to be used to cause confusion or mistake or to deceive purchasers."

2. Chapter 22, title 15, United States Code, Section 1125 (a), (Section 43(a), Trademark Act of 1946), Public Law 489, 79th Congress, Chapter 540, approved July 5, 1946, 60 Stat. 427, as amended by Public Law 710, 81st Congress, 64 Stat. 459, Act of August 17, 1950, and Public Law 593, 82nd Congress, 66 Stat. 792, Act of July 19, 1952:

"Sec. 43 (a). False designations of origin and false descriptions forbidden

Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation."

V. STATEMENT OF THE CASE

Petitioner is the owner of the famous common law and federally registered trademark "JOHNSON'S" for many items of floor maintenance equipment and materials including floor waxes, floor cleaners, wax appliers and floor polishers. These goods have been sold to retail consumers and industrial concerns for the last seventy years under the trademark "JOHNSON'S". Petitioner has spent many millions of dollars establishing "JOHNSON'S" as a trademark in the minds of the purchasing public for such goods.

Respondents use "JOHNSON" on its labels as a trademark for floor mops. Some of respondents' labels display the trademark "JOHNSON" with notations such as "Ask for a Nationally Known JOHNSON MOP" and "It pays to buy a Johnson Mop—FAMOUS FOR QUALITY".

Petitioner brought an action in the United States District Court for the Western District of Tennessee for common law (Tennessee) and federal statutory (Title 15, United States Code, Section 1052 et seq.) trademark infringement against respondent, a resident of Tennessee, to enjoin respondent from using "JOHNSON" as a trademark for floor mops.

The District Court found that the labels for petitioner's liquid waxes and polishes as well as its floor cleaning preparations bear the trademark "JOHNSON'S" in large letters; that petitioner's labels recommend use of mops for application of petitioner's goods to floors; and that in the industrial field many persons use floor mops like respondent's interchangeably with petitioner's wax appliers bearing the trademark "JOHNSON'S". Nevertheless the court con-

cluded that there was no trademark infringement by respondent either under the common law of Tennessee or under federal statutory law, saying:

> "It cannot be believed that one would be confused or would likely be confused in the purchase of a common wet mop bearing the mark "JOHNSON" merely because someone else sold wax and wax applicators under the name "JOHNSON'S". (Conclusion of Law XII, Appendix to Appellant's Brief, page 33a)

The District Court refused to grant petitioner any relief whatever and dismissed the complaint.

The Court of Appeals, erroneously considering the District Court's determination of the issue of likelihood of confusion conclusive under Rule 52(a), Federal Rules of Civil Procedure,[2] affirmed the decision of the lower court and refused to grant even a limited injunction.[3]

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[2] The Third Circuit Court of Appeals in *Perfectform Corporation* v. *Perfect Brassiere Co.*, 257 F(2d) 736, 743 (1958), and in *Sears Roebuck & Co.* v. *Johnson*, 219 F(2d) 590, 591, has held that the question of "likelihood of confusion" in trademark cases is an inference or conclusion derived from "basic facts" and that the appellate tribunal is not bound by the "clearly erroneous" provision of Rule 52(a), Federal Rules of Civil Procedure, and can determine, as advantageously as the District Court, whether or not an inference of likelihood of confusion is warranted.

[3] From the Davids case, infra, down to and including the case of *S. C. Johnson & Son, Inc.* v. *Johnson Products Co.*, infra, the courts have consistently granted at least a limited injunction against use of surname trademarks by latecomers even where there was no showing or inference of wrongful intent.

VI. ARGUMENT

(a) Grounds for Granting Petition for Writ of Certiorari

Petitioner respectfully submits that a writ of certiorari is warranted in the present case on one or more of the following grounds:

1) The decision sought to be reviewed is contrary to the decision of the Supreme Court of the United States in the surname trademark cases of *Thaddeus Davids Company* v. *C. I. Davids*, 233 U.S. 461; 34 S. Ct. 648; 58 L. Ed. 1046 (1914), under the Trademark Act of 1905, and *L. E. Waterman Company* v. *Modern Pen Company*, 235 U.S. 88; 35 S. Ct. 91; 59 L. Ed. 142, under the Trademark Act of 1881, both of which acts were repealed by the Trademark Act of 1946, effective July 5, 1947.

2) The matter of the extent to which a particular surname may be used by more than one party as a trademark for substantially similar goods is a question of great public importance, which must be compared with the necessity for the public to be free of deception and confusion as to the source of origin or sponsorship of goods marketed under identical surname trademarks, particularly in view of the modern tendency toward diversification of lines of manufacture and more intense advertising and merchandising of goods.

If the interpretation of the present trademark laws is to depart or differ from the interpretation heretofore given by the Supreme Court in the Davids and Waterman cases, supra, and by the various circuit courts of appeals, the departure should be passed upon by the Supreme Court and

not left to a circuit court of appeals to turn away from such interpretation.

3) The Supreme Court of the United States has not yet passed on the merits of a surname trademark case under The Trademark Act of 1946, the court having stated in *Steele et al* v. *Bulova Watch Company, Inc.*, 344 U.S. 280; 73 S. Ct. 252; 97 L. Ed. 252 (1952):

> "And since we do not pass on the merits of Bulova's claim, we need not now explore every facet of this complex and controversial act."

4) The decision sought to be reviewed is in conflict with the following decisions of the respective circuit courts of appeals:

(a) Seventh Circuit Court of Appeals, *A. E. Staley Manufacturing Company* v. *Staley Milling Company*, 253 F. (2d); (1958) certiorari denied 357 U.S. 928; 78 S. Ct. 1371; 2 L. Ed. 1370.

(b) Eighth Circuit Court of Appeals, *Cook Chemical Co.* v. *Cook Paint & Varnish Co.*, 185 F. (2d) 365 (1950).

(c) Second Circuit Court of Appeals, *S. C. Johnson & Son, Inc.* v. *Johnson Products Co.*, 116 F. (2d) 427 (CA 2, 1940) (reopening refused 175 F. (2d) 176 (CA 2, 1949) certiorari denied 70 S. Ct. 103; 338 U.S. 860; 94 L. Ed. 527.

(d) Sixth Circuit Court of Appeals, *Neuhoff Inc.* v. *Neuhoff Packing Co.*, 167 F. (2d) 559 (1948).

5) The Sixth Circuit Court of Appeals, contrary to the interpretation of the Federal Rules of Civil Procedure by the Third Circuit Court of Appeals in *Perfectform Corporation* v. *Perfect Brassiere Co.*, 257 F. (2d) 736, 743, and *Sears Roebuck & Co.* v. *Johnson*, 219 F. (2d) 590, 591, ruled in the present case that the holding of the district court on the issue of likelihood of confusion is conclusive upon the appellate tribunal unless shown to be clearly erroneous under Rule 52(a), Federal Rules of Civil Procedure.

(b) Discussion of Grounds for Granting Petition for Writ of Certiorari

Purchasers of commonly used, relatively inexpensive goods such as floor mops and floor waxes are not expected to be highly discriminating or observant in selecting the brand of their choice in the supermarket or department store, whether buying such goods in person or ordering them by telephone or in writing. Millions of dollars are spent daily in television, magazine, radio and newspaper advertising to impress upon the public the desirability of looking or calling for merchandise bearing famous surname trademarks such as "Florsheim", "Gillette", "Ford", "Firestone", "Kellogg's", "Seagram's", "Eastman", "Warner", "Stetson", "Remington", "Edison", "Dunlop", "Miller's", "DuPont", "Parker", and many others, including petitioner's famous trademark "Johnson's".

It is understandable that in the eagerness of a newcomer to "reap where he has not sown", there is a strong temptation for one whose surname is identical with a famous trademark to capitalize upon that fortuity by entering into the same or a similar line of

business, as a consequence of which he may take a "free ride" on the goodwill of the famous trademark owner. Some have brazenly masqueraded under a well-known surname trademark while piously claiming an unlimited right to use "their own" surname (hoping all the while that the public would mistake their goods for those of the true owner of the trademark). Others have employed some guile, artifice or affirmative act to induce the unwary buyer to consciously or subconsciously associate the impersonator's goods with those of the trademark owner. Then there are a few who have deliberately "palmed off" their products as those of the famous trademark owner.

In all such cases, including those in which the latecomer has acted in "good faith", injunctions are not only warranted but normally have been issued. The scope of these injunctions has ranged from an absolute injunction against any use whatever of the surname,[4] to limited injunctions requiring the malefactor to display the entire company name and address in type at least as large as the surname trademark.[5] In some cases a limited injunction has required use of a notation on the labels calling attention to the fact that the latecomer is not connected with the owner of the 'well-known' trademark.[6]

In the present case no relief whatever has been granted. The complaint has been dismissed even

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[4] *Vick Medicine Co.* v. *Vick Chemical Co.*, 11 F(2d) 33 (CA 5, 1926).

[5] *S. C. Johnson & Son, Inc.* v. *Johnson Products, Co.*, 116 F(2d) 427.

[6] *John B. Stetson Co.* v. *Stephen L. Stetson Co. Ltd.*, 85 F(2d) 586.

though the trademarks are the same, there was evidence of actual confusion, and the goods are used interchangeably for applying waxes and cleaners to floors.

The Supreme Court of the United States in the Davids and Waterman cases, supra, clearly established that the "ten year proviso" of the Trademark Act of 1905 afforded to owners of surname trademarks registered under that act the same protection against infringement as that enjoyed by registrants and owners of "arbitrary" or "fanciful" trademarks. Since repeal of the Trademark Act of 1905 (repeal thereof having been provided by and effected on the effective date of the Trademark Act of 1946, namely, July 5, 1947) the Supreme Court has denied certiorari in at least two important surname trademark cases, namely, *S. C. Johnson & Son, Inc.* v. *Johnson Products Co.*, supra, and *A. E. Staley Manufacturing Company* v. *Staley Milling Company*, supra, but in each of those cases injunctive relief was granted in accordance with the principles established by the Supreme Court in the Davids and Waterman cases, supra, and in harmony with decisions in other circuits.

The decision herein sought to be reviewed on certiorari to the Sixth Circuit Court of Appeals, in effect, denies petitioner the protection of the federal trademark statutes as well as the well settled common law of the State of Tennessee.[7] Petitioner, therefore begs this Court, as the court of last resort, to issue a writ of certiorari to the end that justice may be done according to law and the "complex and controversial"

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[7] *Erie Railroad Co.* v. *Tompkins*, 304 U.S. 64, 58 S. Ct. 817, 82 L. Ed. 1188.

Trademark Act of 1946 may be considered on its merits as applied to the surname trademark issue involved in the present case.

To the extent that the Sixth Circuit Court of Appeals considered the determination of the district court conclusive of the issue of likelihood of confusion in trademark cases, under Rule 52(a), Federal Rules of Civil Procedure, such holding is contrary to that of the Third Circuit Court of Appeals on this point in *Perfectform Company* v. *Perfect Brassiere Co.*, supra, and *Sears Roebuck & Co.* v. *Johnson*, supra. In those cases the appellate tribunal distinguished between "basic" facts and "ultimate" facts, the latter being inferences reasonably derived from the basic facts. The court treated the question of "likelihood of confusion" in the trademark cases before it as "a conclusion from the facts" and set aside the district court's finding without holding it to be "clearly erroneous" within the meaning of the rule. The Supreme Court, as the author and final arbiter of the Federal Rules of Civil Procedure is now called upon to resolve the conflict between these circuits as to the interpretation and application of Rule 52(a) to the issue of likelihood of confusion in trademark cases.

CONCLUSION

In view of the substantial importance which every individual attaches to his right to use his own surname in his business and the equal or greater importance of protecting the property rights of those who, by fair dealing and through extensive advertising and sale of high quality goods over nearly three-quarters of a century, have made surnames famous in commerce and industry, and in further view of the aforementioned

conflicts in both substance and procedure between the Sixth Circuit Court of Appeals and other circuit courts of appeals, petitioner respectfully prays that a writ of certiorari be allowed and the judgment of the court below be reviewed and reversed.

Respectfully submitted,

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